

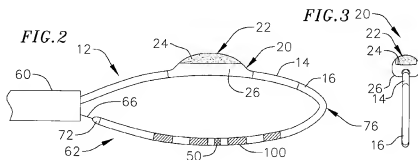
## REMARKS

### I. PRELIMINARY REMARKS

No claims have been canceled. Claims 14, 16, 21 and 25 have been amended.<sup>1</sup> Claims 47-51 have been added. Claims 14-17, 21-23, 25-30, 38, 39 and 45-51 remain in the application. Reexamination and reconsideration of the application, as amended, are respectfully requested.

### II. BRIEF DESCRIPTION OF AN EXEMPLARY EMBODIMENT

The present inventions, as defined by the claims, are directed to probes that may be used for therapeutic purposes. Referring to Figures 2 and 3, one exemplary probe includes a catheter 12 that is carried within a sheath 60. The catheter 12, which may be bent into a loop 62 using a pull wire 66 (Figure 2) or by connecting the catheter to distal end of the sheath 60 (Figure 14), includes a hinge 74 (Figure 13). The hinge is located within the portion of the catheter 12 that forms the apex 76 of the loop 62. An inflatable electrode 20 is supported on the catheter 12.



<sup>1</sup> Claim 16 has simply been rewritten in independent from, including the formalistic change also being made to independent claim 14, in order to clarify the issues on appeal.

### III. REJECTION UNDER SECTION 112

Claim 14 has been rejected under 35 U.S.C. § 112, second paragraph. The rejection under 35 U.S.C. § 112, second paragraph, is respectfully traversed because one of skill in the art would have understood what was being claimed. That issue notwithstanding, applicant respectfully submits that the rejection under 35 U.S.C. § 112, second paragraph, has been obviated by the minor amendment above and should be withdrawn.

### IV. PRIOR ART REJECTIONS

#### A. The Rejections

Claims 14-17, 21-30, 37-39, 45 and 46 have been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of U.S. Patent No. 6,332,880 to Yang ("Yang '880") and U.S. Patent No. 6,076,012 to Swanson ("Swanson '012"). The rejection under 35 U.S.C. § 103 is respectfully traversed to the extent that it is applicable to the claims as amended above. Reconsideration thereof is respectfully requested.

#### B. Preliminary Comments Concerning the Rejection

The explanation of rejection on pages 3-5 ("the explanation") makes a number of references to Figures 40 and 41 of Yang '880, while describing the embodiment actually illustrated in Figures 38 and 39. [Note that column 20 of Yang '880 includes a similar typographical error.] Applicant has assumed that for the purposes of this response that the rejection is based on the embodiment illustrated in Figures 38 and 39. Nevertheless, ***clarification is hereby required.***

The explanation ignores certain aspects of the claims. For example, in what appears to be the portion of the explanation directed to claim 14 (Office Action at page 3), the explanation does not indicate what portion of the Yang '880 device corresponds to the

claimed "hinge portion." For example, is the purported "hinge portion" the entire region of the catheter tube that is coextensive with the spline 254, a portion thereof (and, if so, which portion), or some other region of the catheter tube? ***Applicant hereby requests that the next Office Action clarify this issue by providing a reproduction of Figure 38 with indicia identifying the purported "hinge portion."***

Similarly, with respect to claim 21 (Office Action at page 4), the explanation does not indicate what portion(s) of the Yang '880 device correspond to the claimed "hinge" and "apex of the loop." ***Applicant hereby requests that the next Office Action clarify this issue by providing a reproduction of Figure 38 with indicia identifying the purported "hinge" and "apex of the loop."***

**C. Discussion Concerning the Section 103 Rejection of Claims 14, 15, 17, 38, 39, 45 and 46**

Independent claim 14 calls for a combination of elements comprising "an outer member," "an elongate body carried within the outer member interior bore, the elongate body defining a proximal region, a distal region and a distal end operably connected to the distal end of the outer member, the elongate body including an internal fluid lumen extending from the proximal region to the distal region, and the distal region of the elongate body including **a hinge portion** located proximal of the distal end of the elongate body" and "an inflatable tissue coagulation body supported on the elongate body distal region." The respective combinations defined by claims 15, 17, 38, 39, 45 and 46, *inter alia*, the elements recited in claim 14.

Referring to Figures 38 and 39, Yang '880 discloses a device including a sleeve 256 that is bent into a loop 252 when pushed outwardly from a sheath 258. A spline 254 that defines the shape of the loop 252 is located within the sleeve 256, and electrodes 28 are carried on the sleeve. The Office Action has taken the position that it would have been obvious to add the Swanson '012 porous structure 430, which is also disclosed in Yang '880 (see Figure 82), to the device illustrated in Figures 38 and 39.

Yang '880 and Swanson '012, **which are essentially identical to one another**, do not render the invention defined by independent claim 14 obvious because the combined teachings thereof do not produce the claimed invention. For example, the device illustrated in Figures 38 and 39 of Yang '880 does not include a "hinge portion," as this term would be understood by one of skill in the art who had reviewed the present application. Swanson '012 fails to remedy this deficiency. Accordingly, even assuming for the sake of argument that it would have been obvious to add the Swanson '012 porous structure 430 (Figure 82) to the device illustrated in Figures 38 and 39 of Yang '880, the claimed invention would not have been realized.

In view of the foregoing, applicant respectfully submits that the Office Action failed to establish a *prima facie* case of obviousness of the invention defined by independent claim 14 and that the rejection of claims 14, 15, 17, 38, 39, 45 and 46 under 35 U.S.C. § 103 should be withdrawn.

#### **D. Discussion Concerning the Section 103 Rejection of Claim 16**

Independent claim 16 includes, *inter alia*, the elements recited in independent claim 14 and, therefore, is patentable over Yang '880 and Swanson '012 for the at least the reasons presented in Section IV-C above.

Independent claim 16 also indicates that the claimed "sensing element" and the "inflatable tissue coagulation body" are on **different sides** (i.e. one proximal and the other distal) of the "hinge portion." The Office Action asserted that it would have been obvious to move the Yang '880 temperature sensing elements 540 (Figure 3A) off the electrode elements 28 and/or the inflatable structure 430 (Figure 82) and, apparently, onto the other side of the yet to be identified "hinge portion" because "rearranging parts of an invention involves only routine skill in the art" and cited *In re Japinske*, 86 USPQ 70 (CCPA 1950) in support. [Office Action at page 4.] Although the Examiner did not specify which portion of the *Japinske* decision supports the assertion in the Office Action, the portion that at least appears to be applicable reads as follows:

In the brief of the Solicitor for the Patent Office it is pointed out that the claim reads on Cannon except as to the final limitation reading "means

disposed in alignment with said opening for contact by said depending means to start the pressing operation of said hydraulic press.” As to that limitation it was held that there would be no invention in shifting the starting switch disclosed by Cannon to a different position ***since the operation of the device would not thereby be modified.***

We find no error in the holding as to claim 3.

86 USPQ at 73, *emphasis added*. Contrary to the situation in *Japinske*, the modification proposed in the outstanding Office Action would clearly change the operation of the Yang/Swanson device. The purpose of the Yang ‘880 (and Swanson ‘012) temperature sensing elements 540 is to sense temperature at the electrode elements 28 in order to control the energy supplied to the electrode elements. [Column 37, lines 52-65.] Moving the temperature sensing elements 540 away from the electrode elements 28 would clearly change “the operation of the device” and, accordingly, the *Japinske* decision does not support a conclusion of obviousness.

In view of the foregoing, applicant respectfully submits that the Office Action failed to establish a *prima facie* case of obviousness and that the rejection of claim 16 under 35 U.S.C. § 103 should be withdrawn.

#### **E. Discussion Concerning Claims 21-30**

Independent claim 21 calls for a combination of elements including, *inter alia*, “an elongate catheter tube, defining a distal region that supports the tissue coagulation body and a distal end, adapted to be carried within the outer member interior bore and extend outwardly from the interior bore such that the distal region forms a loop, ***the elongate catheter tube including a hinge*** located proximal of the distal end and ***defining the apex of the loop*** formed by the distal region, ***the apex of the loop having a flexibility that is greater in a bending direction than the flexibility of the portions of the elongate catheter tube.***” The combinations defined by claims 22-30 include, *inter alia*, the elements recited in claim 21.

Referring to Figures 38 and 39, Yang ‘880 discloses a device including a sleeve 256 that is bent into a loop 252 when pushed outwardly from a sheath 258. A spline 254

that defines the shape of the loop 252 is located within the sleeve 256, and electrodes 28 are carried on the sleeve. The Office Action has taken the position that it would have been obvious to add the Swanson '012 porous structure 430, which is also disclosed in Yang '880 (see Figure 82), to the device illustrated in Figures 38 and 39.

Yang '880 and Swanson '012, ***which are essentially identical to one another***, do not render the invention defined by independent claim 21 obvious because the combined teachings thereof do not produce the claimed invention. For example, the device illustrated in Figures 38 and 39 of Yang '880 does not include a "***hinge*** ... defining the apex of the loop." That issue notwithstanding, if one were to take the position that the apex of the Yang '880 loop 252 (which the Office Action failed to identify) is located at some point along the length of the spline 254, there is no such point where the flexibility of the spline 254/sleeve 256 is greater in a bending direction than the flexibility of the portions of the spline 254/sleeve 256 that are immediately proximal ***and*** distal thereto. Swanson '012 fails to remedy this deficiency. Accordingly, even assuming for the sake of argument that it would have been obvious to add the Swanson '012 porous structure 430 (Figure 82) to the device illustrated in Figures 38 and 39 of Yang '880, the claimed invention would not have been realized.

As the cited references fail to teach or suggest the combination of elements recited in independent claim 21, applicant respectfully submits that the rejection of claims 21-30 under 35 U.S.C. § 103 should be withdrawn.

## **V. NEWLY PRESENTED CLAIMS 47-51**

Newly presented claim 47 depends from independent claim 14 and is patentable for the same reasons as independent claim 14.

Newly presented claims 48-51 depend from independent claim 16 and is patentable for the same reasons as independent claim 16.

## VI. CLOSING REMARKS

In view of the foregoing, it is respectfully submitted that the claims in the application are in condition for allowance. Reexamination and reconsideration of the application, as amended, are respectfully requested. Allowance of the claims at an early date is courteously solicited.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call applicant's undersigned representative at (310) 563-1458 to discuss the steps necessary for placing the application in condition for allowance.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-0638. Should such fees be associated with an extension of time, applicant respectfully requests that this paper be considered a petition therefor.

Respectfully submitted,

3/20/2009

Date

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